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10/748,681	12/31/2003	Ross Koningstein	16113-001001	1968
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FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			BRANDENBURG, WILLIAM A	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/748,681	<b>Applicant(s)</b> KONINGSTEIN, ROSS
	<b>Examiner</b> WILLIAM A. BRANDENBURG	<b>Art Unit</b> 4115

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 31 December 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-51 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-51 is/are rejected.

7) Claim(s) 1-17 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 31 December 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement (PTO-1448)  
Paper No(s)/Mail Date 8/4/05, 12/6/05, 12/28/05

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. The following is a non-final, first office action on the merits in response to application filed on 12/31/2003. Claims 1-51 are pending.

***Priority***

2. Applicant's claim for the benefit of a prior-filed provisional application, U.S. Patent Application No. 60/516,281 filed November 3, 2003, under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

***Information Disclosure Statement***

3. The information disclosure statements (IDS) submitted on 08/04/2005, 12/06/2005 and 12/28/2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

***Specification***

4. The disclosure is objected to because of the following informalities:
  - a. On page 1, line 12 of the disclosure under the Related Application heading, the reference to the co-pending and commonly assigned application is cited according to the attorney docket number. This should be cited according to the co-pending applications' U.S. Patent Application Number.
  - b. On page 6, line 4 of the disclosure, element 100 is referred to as an exemplary electronic document, but on page 8, line 2 of the disclosure, element 100 is referred to as an exemplary advertisement.

Appropriate correction is required.

***Claim Objections***

5. Claims 1-17 are objected to because of the following informalities. Claims 12-17 recite a "method", while the preceding claims 1-11 recite a "computer-implemented method." Preamble consistency in related claims is optimal in order to avoid unnecessary confusion.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 16, 20 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 16 recites "an electronic document that interfaces with a user." It is unclear how a document actually interfaces with a human. Applicant must particularly point out and distinctly claim the subject matter regarded as the invention.
- b. Claims 3, 20 and 37 recite a "morphing electronic document." It is unclear how a document is morphed. If the claim is referring to the image being morphed, then Applicant must particularly point out and distinctly claim the subject matter applicant regards as the invention.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-18, 20-35 and 37-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Morgenthaler et al. (U.S. 2002/0032677).

1. A computer-implemented method for advertising comprising the steps of:
  - delivering an electronic advertisement comprising one or more menu options (Fig. 8A, display menu options) and a reference to a network location ([0004-5], assigned uniform resource locators (URL's)) **for retrieving specified content associated with each menu option for inclusion in a first electronic document;**
  - receiving a selection of one or more menu options from the electronic advertisement ([0145], based on an end user's selection of manner to view a graphical search query);
  - delivering a second electronic document including content from the referenced network location associated with the menu option selected, the second electronic document including the electronic advertisement ([0145], view query matching results in a slide show format as shown in Figs. 8-13) .

3. The computer-implemented method of claim 1 wherein the electronic advertisement comprises a morphing electronic advertisement that includes a first display format (Fig. 7, text only), a second display format (Fig. 7, text plus thumbnail images) and instructions (Fig. 9A, code embedded in top menu options, see also [0004-8]) **for interpreting user actions to enable an end user system to display both formats.**
4. The computer-implemented method of claim 1 wherein the first and second electronic document comprise web pages (Fig. 11, web page displayed).
5. The computer-implemented method of claim 1 wherein the network locations ([0004-5], assigned uniform resource locators (URL's)) specified in reference to the menu options (Fig. 8A, display menu options) comprise network locations provided by or affiliated with a host entity that delivered the first electronic document and electronic advertisement ([0008], retrieves the text-based information and links the corresponding URL back to the search engine - host).
6. The computer-implemented method of claim 1 further comprising the steps of:  
storing a price parameter value ([0155], pricing) in association with one or more advertisements **for performance by end users viewing the advertisement** ([0155], click-throughs of the displayed advertisements); and

wherein the advertisement comprises a target reference to an advertiser network location ([0155], the Internet end user clicks on the advertisement within Room102.com to access the advertising company's website).

7. The computer-implemented method of claim 6 wherein performance is determined to have occurred when an end user selects the target reference ([0013], Click-through).

8. The computer-implemented method of claim 6 wherein performance is determined to have occurred based on user activity associated with the second display format ([0013], Click-through, generating revenue).

9. The computer-implemented method of claim 8 wherein the user activity comprises a predetermined period of time viewing the second display format (Fig. 9A, graphical advertisement viewed, see also [0147], predetermined time delay for ad display).

10. The computer-implemented method of claim 8 wherein the user activity comprises the user request to view the second display format ([0145], view query matching results in a slide show format as shown in Figs. 8-13).

11. The computer-implemented method of claim 8 wherein the user activity comprises a predetermined number of user selections of menu options (Fig. 18A, Click for cat boarding, see also [0147], user selects from slide tab predetermined sequence)

available in the second display format.

12. The method of claim 1 further comprising the step of associating a reference to the advertisement ([0008], links the corresponding URL) **for use by the user in retrieving the advertisement.**

13. The method of claim 12 wherein the user may bookmark the advertisement using the reference ([0147], bookmark this screen shot).

14. The method of claim 1 wherein the second electronic document comprises a document provided by the advertiser (Fig. 12, graphical advertisement from the advertiser displayed).

15. The method of claim 14 wherein the document provided by the advertiser comprises a web page from the advertiser's web site (Fig. 11, graphical advertisement in the form of a web page).

16. The method of claim 1 wherein the second electronic document comprises an electronic document that interfaces with a user (Fig. 18, click for cat boarding interface) **to permit the user to purchase one or more items.**

17. The method of claim 16 further comprising the steps of receiving feedback ([0055],

monitoring via cookie) information related to a user's purchase of one or more items ([0055], items purchased).

18. An apparatus for delivering advertising comprising the steps of:

an electronic advertisement output means (internet browser) for delivering an electronic advertisement comprising one or more menu options (Fig. 8A, display menu options) and a reference to a network location ([0004-5], assigned uniform resource locators (URL's)) **for retrieving specified content associated with each menu option;**

selection receiving means (hyperlink) for receiving a selection of one or more menu options from the electronic advertisement ([0145], Based on an end user's selection of manner to view a graphical search query);

delivery means (server) for delivering a second electronic document including content from the referenced network location associated with the menu option selected, the second electronic document including the electronic advertisement ([0145], view query matching results in a slide show format as shown in Figs. 8-13).

20. The apparatus of claim 18 wherein the electronic advertisement comprises a morphing electronic advertisement that includes a first display format (Fig. 7, text only), a second display format (Fig. 7, text plus thumbnail images) and instructions (Fig. 9A, code embedded in top menu options, see also [0004-8]) **for interpreting user actions to enable an end user system to display both formats.**

21. The apparatus of claim 18 wherein the first and second electronic document comprise web pages (Fig. 11, web page displayed).
22. The apparatus of claim 18 wherein the network locations [0004-5], assigned uniform resource locators (URL's) specified in reference to the menu options (Fig. 8A, display menu options) comprise network locations provided by or affiliated with a host entity that delivered the first electronic document and electronic advertisement ([0008], retrieves the text-based information and links the corresponding URL back to the search engine – host).
23. The apparatus of claim 18 further comprising:

storage means (database) for storing a price parameter value ([0155], pricing) in association with one or more advertisements **for performance by end users viewing the advertisement** ([0155], click-throughs of the displayed advertisements); and

wherein the advertisement comprises a target reference to an advertiser network location ([0155], the Internet end user clicks on the advertisement within Room102.com to access the advertising company's website).
24. The apparatus of claim 23 wherein a wherein performance is determined to have occurred when a user selects the target reference ([0013], Click-through).

25. The apparatus of claim 23 wherein performance is determined to have occurred based on user activity associated with the second display format ([0013], Click-through, generating revenue).
26. The apparatus of claim 25 wherein the user activity comprises a predetermined period of time viewing the second display format (Fig. 9A, graphical advertisement viewed, see also [0147], predetermined time delay for ad display).
27. The apparatus of claim 25 wherein the user activity comprises the user request to view the second display format ([0145], view query matching results in a slide show format as shown in Figs. 8-13).
28. The apparatus of claim 25 wherein the user activity comprises a predetermined number of user selections of menu options (Fig. 18A, Click for cat boarding, see also [0147], user selects from slide tab predetermined sequence) available in the second display format.
29. The apparatus of claim 18 further comprising storage means (database) that stores a reference to the advertisement ([0008], links the corresponding URL) ***for use by the user in retrieving the advertisement.***
30. The apparatus of claim 29 wherein the user may bookmark the advertisement using

the reference ([0147], bookmark this screen shot).

31. The apparatus of claim 18 wherein the second electronic document comprises a document provided by the advertiser (Fig. 12, graphical advertisement from the advertiser displayed).
32. The apparatus of claim 31 wherein the document provided by the advertiser comprises a web page from the advertiser's web site (Fig. 11, graphical advertisement in the form of a web page).
33. The apparatus of claim 18 wherein the second electronic document comprises an electronic document that interfaces with a user (Fig. 18, click for cat boarding interface) ***to permit the user to purchase one or more items.***
34. The apparatus of claim 33 further comprising feedback means ([0055], monitoring via cookie) for receiving feedback information related to a user's purchase of one or more items ([0055], items purchased).
35. An apparatus for delivering advertising comprising the steps of:  
an electronic advertisement output system (Internet) for delivering an electronic advertisement comprising one or more menu options (Fig. 8A, display menu options)

and a reference to a network location ([0004-5], assigned uniform resource locators (URL's)) **for retrieving specified content associated with each menu option**;  
a selection receiving module (routine) that receiving a selection of one or more menu options from the electronic advertisement ([0145], Based on an end user's selection of manner to view a graphical search query);  
a delivery module (Internet browser) that delivers a second electronic document including content from the referenced network location associated with the menu option selected, the second electronic document including the electronic advertisement ([0145], view query matching results in a slide show format as shown in Figs. 8-13)).

37. The apparatus of claim 35 wherein the electronic advertisement comprises a morphing electronic advertisement that includes a first display format (Fig. 7, text only), a second display format (Fig. 7, text plus thumbnail images) and instructions (Fig. 9A, code embedded in top menu options, see also [0004-8]) **for interpreting user actions to enable an end user system to display both formats**.

38. The apparatus of claim 35 wherein the first and second electronic document comprise web pages (Fig. 11, web page displayed).

39. The apparatus of claim 35 wherein the network locations ([0004-5], assigned uniform resource locators (URL's)) specified in reference to the menu options (Fig. 8A, display menu options) comprise network locations provided by or affiliated with a host

entity that delivered the first electronic document and electronic advertisement ([0008], retrieves the text-based information and links the corresponding URL back to the search engine - host).

40. The apparatus of claim 35 further comprising:

a database system (Fig. 19, Relational Database) for storing a price parameter value ([0155], pricing) in association with one or more advertisements **for performance by end users viewing the advertisement** ([0155], click-throughs of the displayed advertisements); and

wherein the advertisement comprises a target reference to an advertiser network location ([0155], the Internet end user clicks on the advertisement within Room102.com to access the advertising company's website).

41. The apparatus of claim 35 wherein a wherein performance is determined to have occurred when a user selects the target reference ([0013], Click-through).

42. The apparatus of claim 35 wherein performance is determined to have occurred based on user activity associated with the second display format ([0013], Click-through, generating revenue).

43. The apparatus of claim 42 wherein the user activity comprises a predetermined period of time viewing the second display format (Fig. 9A, graphical advertisement

viewed, see also [0147], predetermined time delay for ad display).

44. The apparatus of claim 42 wherein the user activity comprises the user request to view the second display format ([0145], view query matching results in a slide show format as shown in Figs. 8-13).

45. The apparatus of claim 42 wherein the user activity comprises a predetermined number of user selections of menu options (Fig. 18A, Click for cat boarding, see also [0147], user selects from slide tab predetermined sequence) available in the second display format.

46. The apparatus of claim 35 further comprising a storage system (Fig. 19, Relational Database) that stores a reference to the advertisement ([0008], links the corresponding URL) **for use by the user in retrieving the advertisement.**

47. The apparatus of claim 45 wherein the user may bookmark the advertisement using the reference ([0147], bookmark this screen shot).

48. The apparatus of claim 35 wherein the second electronic document comprises a document provided by the advertiser (Fig. 12, graphical advertisement from the advertiser displayed).

49. The apparatus of claim 47 wherein the document provided by the advertiser comprises a web page from the advertiser's web site (Fig. 11, graphical advertisement in the form of a web page).

50. The apparatus of claim 35 wherein the second electronic document comprises an electronic document that interfaces with a user (Fig. 18, click for cat boarding interface) ***to permit the user to purchase one or more items.***

51. The apparatus of claim 49 further comprising a feedback module (Fig. 4, searchable graphical database) that receives feedback information ([0055], monitoring via cookie) related to a user's purchase of one or more items ([0055], items purchased).

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 19 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgenthaler et al. (U.S. 2002/0032677) in view of Merritt (U.S. 7,058,593).  
Morgenthaler discloses the method/apparatus for advertising comprising the steps of:  
delivering an electronic advertisement comprising one or more menu options (Fig. 8A, display menu options) and a reference to a network location ([0004-5],

assigned uniform resource locators (URL's)) **for retrieving specified content associated with each menu option for inclusion in a first electronic document;**

receiving a selection of one or more menu options from the electronic advertisement ([0145], Based on an end user's selection of manner to view a graphical search query);

delivering a second electronic document including content from the referenced network location associated with the menu option selected, the second electronic document including the electronic advertisement ([0145], view query matching results in a slide show format as shown in Figs. 8-13) .

Morgenthaler does not explicitly disclose a "home menu option" present in the electronic advertisement. However, Merritt teaches a "home button" wherein one of the menu options includes a home menu option (Merritt, Fig. 1, "HOME") and further comprising the steps of:

receiving a selection of the home menu option (Merritt, Fig. 29/Element 444, "SELECT "RETURN TO CSTAKES HOME""); and

delivering the first electronic document including the electronic advertisement (Merritt, Column 6, Lines 50-51, "user would be returned to the HOME SCREEN").

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a home menu option in an advertisement to allow a user to easily and quickly return to the previous original screen by selecting said menu option instead of using a

process of forward-link-backward-link to navigate. This aids in keeping the advertisement of front of the user as long as possible, thus making advertisements more effective for the advertisers.

*As per claims 7, 8, 24, 25, 41 and 42, please note that language such as “determined to have occurred” are considered optional language and need to be positively recited, because they do not narrow the claims and can always be omitted. See e.g. MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) (“As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.”).*

### ***Conclusion***

10. Please note the Examiner has bolded and italicized some of the preceding claim language to address intended use recitation. Please make the appropriate corrections as per the following:

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See e.g. *In re Collier*, 158 USPQ 266, 267 (CCPA 1968)(where the court interpreted the claimed phrase “a connector

member for engaging shield means" and held that the shield means was not a positive element of the claim since "[t]here is no positive inclusion of 'shield means' in what is apparently intended to be a claim to structure consisting of a combination of elements."

11. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM A. BRANDENBURG whose telephone number is (571)270-5488. The examiner can normally be reached on Monday-Thursday 6:30 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on 571-272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WB

/Bradley B Bayat/  
Supervisory Patent Examiner, Art Unit 3621